

Application No. 10/604,531
Docket No. H-205829-div
Amendment dated December 1, 2005
Reply to Office Action of September 12005

REMARKS

In the Office Action, the Examiner reviewed claims 1-16 of the above-identified US Patent Application, with the result that claims 1 and 8-10 were rejected under 35 USC §102, and claims 2-7 and 11-16 were deemed to recite allowable subject matter. In response, Applicants have amended the claims as set forth above. More particularly:

Independent claims 1 and 10 and dependent claim 8 have been amended to clarify that the surface to which the coating system is fused is a tooling surface (14) of the screen tooling (10).

Independent claim 1 has been further amended to recite the presence of a porous fiber preform (12) on the screen tooling (10), and that the fiber preform (12) has a shape corresponding to the tooling surface (14) of the tooling (10).

New independent claim 17 has been presented that is identical to original claim 1 except for incorporating the limitations of claim 2, pursuant to the Examiner's conclusion that claim 2 (which depends from claim 1) recited allowable subject matter. New dependent claims 18 and 20 correspond to original claims 3 and 8, and new claim 19 recites subject matter found paragraphs [0006] and [0016] of the specification. As such, new independent claim 17 and its dependent claims 18-20 are believed to be allowable over the

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prior art of record.

Applicants believe that the above amendments do not present new matter. Favorable reconsideration and allowance of claims 1-20 are respectfully requested in view of the above amendments and the following remarks.

Rejection under 35 USC §102

Independent claims 1 and 10 and dependent claims 8 and 9 (which depend from claim 1) were rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 5,601,712 to Adams et al. (Adams). Applicants respectfully request reconsideration of this rejection in view of the amendments presented above as well as the following comments.

As noted in §2131 of the MPEP:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the ...claim. The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e. identity of terminology is not required. (Citations omitted).

Applicants' amended independent claim 1 requires the presence of a porous fiber preform (12) on the screen tooling (10), and that the fiber preform

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(120 has a shape corresponding to the tooling surface (14) of the tooling (10).

Adams neither discloses or suggests such a limitation, as Adams' drum 12 is merely intended to separate liquids from biological wastes. As such, Applicants believe that Adams does not anticipate independent claim 1 or any of its dependent claims under the test for anticipation set forth at MPEP §2131.

Applicants' independent claim 10 requires a "screen tooling installed in a directed fiber preforming apparatus." Adams neither discloses or suggests that the drum 12 is installed in a directed fiber preforming apparatus.

Furthermore, the limitation for the screen tooling actually being installed in a directed fiber preforming apparatus is not merely an intended use, since claim 10 requires that the screen tooling is physically installed in the apparatus.

Finally, when considering what effect is to be given a claim's preamble language, the court in *Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 9 USPQ2nd 1962 (Fed. Cir. 1989) stated:

No litmus test can be given with respect to when the introductory words of a claim, the preamble, constitute a statement of purpose for a device or are, in themselves, additional structural limitations of a claim. . . . The effect preamble language should be given can be resolved only on review of the entirety of the patent to gain an understanding of *what the inventors actually invented and intended to encompass by the claim*. (Emphasis added).

9 USPQ2nd at 1966

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Because a "litmus test" does not exist for ascertaining the effect of recitations in a claim preamble, such recitations cannot be deemed as merely an intended use simply because they were placed in the preamble. To the contrary, Applicants believe that, upon review of the entirety of their specification and what their invention is intended to encompass as required by MPEP §§2111.02 and 2163II.A.1 (citing *Corning Glass Works*, *supra*), the recitation of a "screen tooling installed in a directed fiber preforming apparatus" does serve as a positive limitation to the scope of the claim, as such a requirement limits the type of screen tooling being claimed.

Also pertinent to this issue is MPEP §2111.02, which states that

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. . . . In claims directed to articles and apparatus, any phraseology in the preamble that limits the structure of that article or apparatus must be given weight. (Emphasis added).

Therefore, Applicants respectfully believe that the preamble of independent claim 10 cannot be ignored in order to maintain the present rejection because, paraphrasing *In re Stencil*, 4 USPQ2d 1071 (Fed. Cir. 1987),

the framework - the teachings of the prior art - against which patentability is measured is not all [screen tooling] broadly, but [screen tooling] suitable for use in combination with [a directed fiber preforming apparatus], for the claims are so limited.

4 USPQ2nd at 1073

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As such, Applicants believe that the preamble of claim 10 cannot be ignored for purposes of a rejection under 35 USC §102, and therefore Adams does not disclose the "screen tooling installed in a directed fiber preforming apparatus" required by independent claim 10 and its dependent claims.

For all of the above reasons, Applicants respectfully request withdrawal of the rejection under 35 USC §102.

Closing

Should the Examiner have any questions with respect to any matter now of record, Applicants' representative may be reached at (219) 462-4999.

Respectfully submitted,

By *Domenica N.S. Hartman*
Domenica N.S. Hartman
Reg. No. 32,701

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Hartman & Hartman, P.C.
Valparaiso, Indiana 46383
TEL.: (219) 462-4999
FAX: (219) 464-1166